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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,324	03/16/2001	Steven M. Schein	ST/ 028 CONT 2	9059

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EXAMINER

TRAN, HAI V

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,324

Applicant(s)

SCHEIN ET AL.

Examiner

Hai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/16/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claim 1-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Herz et al (US 5,758,257).

Regarding claim 1, an interactive program guide having a display screen comprising:

A database for storing television schedule information including television program titles (Col 25, lines 16-18). For instance, at col.25, line 16, Herz discloses “storing at the set top multimedia terminal....” . Clearly, this meets the limitation of storing television schedule information including television program titles.

A display controller electrically coupled to the database for displaying some of the schedule information including television program titles on the screen (Col.5, lines 13-15).

An input device for selecting a displayed program title displayed on the screen (RC 1008; Fig. 10);

A processor (Fig. 10, el. 1006) for identifying data related to the selected program from the Internet;

A communication device (Fig. 10, el. 1020) for receiving the identified data related to the selected program; and

A controller for displaying the received data related to the selected program on the screen (Col.46, lines 54-60 and Col. 51, lines 3-65+).

Regarding claim 2, wherein the database resides on one or more remote file servers accessible through a communication link (Col.46, line 65-67).

Regarding claim 3, wherein the communication link is Internet (Col.51, lines 6-7).

Regarding claim 4, wherein the related data is advertisement (Col.47, lines 59-67 and Col.48, lines 1-5).

Regarding claim 5, Herz further discloses means for monitoring (Col.14, lines 3-7) and storing user's selections of television programs (Col.25, lines 37-41);

Means for learning a user's preference according to the user's selections of the television programs (Col. 6, lines 50-57);

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Means for activating the program guide responsive to the stored user preference (for reminding the user to view the preferred television program; Col.23, lines 1-7);

Regarding claim 6, wherein means for learning a user-preference comprises means for storing a user preference responsive to a user input (Col.22, lines 19);

Regarding claim 7, wherein the user preference is a television program (Col.25, lines 16-18).

Regarding claim 8, wherein the user preference is a theme for a plurality of television programs (Col. 4, lines 32-34).

Regarding claim 9, wherein the activating means comprises means for reminding the user to view the preferred television program (Col.23, lines 1-7).

Regarding claim 10, wherein the activating means comprises means for recording the preferred television program (a record is kept of all movies or shows watched by all customers) (Col. 1, lines 50-55 and Col.38, lines 42-43).

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Regarding claim 11, wherein the activating means comprises means for downloading a copy of the preferred television program to a digital storage medium (memory) (Col.51, lines 40-52).

Regarding claim 12, wherein the activating means comprises means for searching (navigation through a tree) the schedule information; means for matching television programs (sports program) having the same theme as the stored theme (his or viewing preference)(Col. 51, lines 36-52); and means for recording the matched television programs (Col.2, lines 1- 12).

Regarding claim 13, wherein the activating means comprises means for searching (navigation through a tree) the schedule information; means for matching television programs (sports program) having the same theme as the stored theme (his or viewing preference); and downloading a copy of the matched television program to a digital storage medium (memory) (Col.51, lines 36-52).

Regarding claim 14, wherein the activating means comprises of means for adapting the schedule information displayed on the screen according to the user-preference (Col.46, line 43-59).

Regarding claim 15, further comprising:

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means for displaying preview programming for future-scheduled television program (Col.48, lines 48-55);

means for identifying a plurality of sources of information (Col.4, lines 33) having data ("characteristics" , Col.4, lines 64-67) related to the future-scheduled television program;

means for selecting (Col.5, lines 16-17) an identified source of information having data related to the future-scheduled television programs

means responsive (to receive the program selected) to the selected source of information (Fig.10, Col.46, lines 24-59); and

means for displaying data from the linked source of information (on-line service) on the screen (Col.46, lines 54-60).

Regarding claim 16, wherein the data related to the future-scheduled television program is one or more advertisement, video preview, and textual information (Col. 51, lines 5-28 and lines 50-52);

Regarding claim 17, further comprising means for storing and displaying advertisement data (Col.47, lines 59-67 and Col.48, lines 1-5).

Regarding claim 18, wherein the related data is one or more of selected TV program actors, actresses, theme, other broadcast times, other broadcast sources, and associated available products (Col.51, lines 48-55).

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Claim 19 is analyzed with respect to claim 1

Claim 20 is analyzed with respect to claim 2

Claim 21 is analyzed with respect to claim 3

Claim 22 is analyzed with respect to claim 4

Claim 23 is analyzed with respect to claim 5

Claim 24 is analyzed with respect to claim 6

Claim 25 is analyzed with respect to claim 7

Claim 26 is analyzed with respect to claim 8

Claim 27 is analyzed with respect to claim 9

Claim 28 is analyzed with respect to claim 10

Claim 29 is analyzed with respect to claim 11

Claim 30 is analyzed with respect to claim 12

Claim 31 is analyzed with respect to claim 13

Claim 32 is analyzed with respect to claim 14

Claim 33 is analyzed with respect to claim 15

Claim 34 is analyzed with respect to claim 18

Claim 35 is analyzed with respect to claim 16

Claim 36 is analyzed with respect to claim 17

Claim 37 is analyzed with respect to claim 18

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude"

granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-5, 8-10, 14-15, 17-19 of U.S. Patent No. 6,002,394. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 1 recites all the limitations of the Patent claims 1, 17 and 19 with additional limitation "a database...", "a display controller electrically coupled to the data base...", "an input device...", "a processor...", "a communication device..." and "a controller...". It would have been obvious to modify patent claims 1, 17 and 19 to include the additional features in order to clearly define the all the specific elements within the interactive television system.

Allowance of claim 1 would result in the unwarranted time-use extension of the monopoly granted for the invention as defined in patent claims 1, 17 and 19.

Claims 2-3 correspond to Patent claims 1, 15, 17 and 19.

Claim 4 corresponds to Patent claim 14.

Claim 5 corresponds to Patent claims 3 and 18.

Claim 6 corresponds to Patent claim 8.

Claims 7, 8 correspond to Patent claims 4 and 8.

Claims 9, 10, 11 correspond to Patent claims 4 and 9.

Claims 12, 13 correspond to Patent claims 8 and 9.

Claim 14 corresponds to Patent claims 5 and 10.

Claim 15 corresponds to Patent claim 15.

Claims 16 and 17 corresponds to patent claim 14.

Claim 18 corresponds to patent claim 1, 17 and 19.

Claim 19-37 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-5, 8-10, 14-15, 17-19 of U.S. Patent No. 6,002,394. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 19 is broader than Patent claims 1, 17 and 19. It would have been obvious to broadly modify patent claims 1, 17 and 19 so to obtain Application claim 19.

Allowance of claim 19 would result in the unwarranted time-use extension of the monopoly granted for the invention as defined in patent claims 1, 17 and 19.

Claims 20-21 correspond to Patent claims 1, 15, 17 and 19.

Claim 22 corresponds to Patent claim 14.

Claim 23 corresponds to Patent claims 3 and 18.

Claim 24 corresponds to Patent claim 8.

Claims 25-26 correspond to Patent claims 4 and 8.

Claims 27-29 correspond to Patent claims 4 and 9.

Claims 30-31 correspond to Patent claims 8 and 9.

Claim 32 corresponds to Patent claims 5 and 10.

Claim 33 corresponds to Patent claim 15.

Claims 35-36 corresponds to patent claim 14.

Claim 37 corresponds to patent claim 1, 17 and 19.

- Furthermore, since Terminal Disclaimer (T.D.) has already been filed between Application US 6,263,501 (issued 07/17/2001) and US 6,002,394 (issued 12/14/1999) and due to the claims already being established as obvious in view of the terminal disclaimer filed by applicant. Upon the determination that a T.D. will be filled based on the Obvious Double Patenting as stated above, terminally disclaiming against all patents identified by the Examiner is also required.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Miller et al. (US 5,585,866) shows an electronic television program guide schedule system and method including virtual channels.

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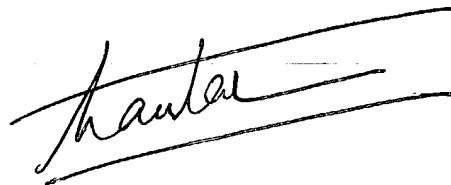
Herz et al (US 6,020,883) shows a system and method for scheduling broadcast of and access to video programs and other data using customer profiles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is 703-308-7372. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HT:ht
10/27/2004

A handwritten signature in black ink, appearing to read 'Hai Tran', is written over two horizontal lines.

HAI TRAN
PATENT EXAMINER